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IN THE

Supreme Court of the United States

OCTOBER TERM, 1956

No. 444

TATKO BROTHERS SLATE CO., INC.,
Petitioner,

v.

VERMONT STRUCTURAL SLATE CO., INC.,
Respondent.

PETITIONER'S REPLY BRIEF

W. BROWN MORTON, JR.,
247 Park Avenue,
New York 17, N. Y.,
Attorney for Petitioner.

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Respondent takes the position (Brief in Opposition, p. 3) that the standards governing patentability have been clearly defined for more than a century and that these long recognized standards were finally codified in Section 103 in the Patent Act of 1952 (35 U. S. C. § 103). The error of this is pointed up by Judge Kalodner in the recently decided case of *R. M. Palmer Company* v. *Luden's, Inc.*, 236 F. 2d 496 (3 Cir. 1956) where it is stated:

> "The provisions of Section 103, 35 U. S. C., 1952 ed., as set forth in footnote 3, are new. The purpose of the provisions as stated by the Reviser is to achieve a stabilizing effect, and to render immaterial whether the invention resulted from 'flash of genius'.
>
> "* * * To what extent a change is wrought would seem to depend upon the preexisting views of a tribunal as to the standard which it has determined patentability * * *" (p. 499).

Respondent takes the position that petitioner's asserted "confusion" over interpretation of Section 103 relating to standards of patentability is imaginary and at best wishful thinking. The error of this position and the existing confusion is demonstrated by *Blish Hardware Co.* v. *Time Saver Tools, Inc.*, —— F. 2d ——, 111 USPQ 6 (10 Cir. 1956) wherein the Court said:

> "* * * It is agreed that the statutory standards for invention are but the codification of the common law—some courts say, as it has existed for the past one hundred years without recognition of any change in the inventive concept. Interstate Rubber Products Corp. v. Radiator Specialty Co., Inc., 214 F. 2d 546, 102 USPQ 224. Others say, as it existed at the time of codification. Bobertz v. General Motors Corp., 228 F. 2d 94, 107 USPQ 338; General Motors Corp. v. Estate Stove Co., 203 F. 2d 912, 97 USPQ 88; Wasserman v. Burgess & Blacher Co., 217 F. 2d 402, 103 USPQ 368; Seismograph Serv. Corp. v. Offshore Raydist, Inc., 135 F. Supp. 342, 107 USPQ 104; Burt v. Bilofsky, 120 F. Supp. 822, 101 USPQ 169. Still another court says that the underlying legislative intent was to ameliorate the harshness of the inventive concept inherent in the authoritative cases of the past two decades. Lyon v. Bausch & Lomb Optical Co., 224 F. 2d 530, 106 USPQ 1, cert. denied 350 U. S. 911, 107 USPQ 362 * * *" (p. 7).

Respondent attempts to factually distinguish the District Court's decision in the *Vermont* case (*Tatko Brothers Slate Co., Inc.* v. *Matthew Hannon*, —— F. Supp. —— (D. Vt. 1956) from the decision of the court below. It seems obvious that the conflict is in judicial thinking rather than in the facts before those courts.

Respondent states "The question whether certain subject matter is patentable has always been one of law"

(Brief in Opposition, p. 8). The factual nature of the question of patentability and the necessity of evidence to meet the test was recognized by the court below in *Welsh Manufacturing Co.* v. *Sunware Products Co.,* 236 F. 2d 225 (2 Cir. 1956) decided after the decision in the case at bar. There Judge Lumbard stated:

> "[4] We think it clear that even under the relaxed standard of invention of Lyon v. Bausch & Lomb Optical Co., 2 Cir., 1955, 224 F. 2d 530, there was no invention here. It is not enough to show that the patentee's device was new and useful. It must in addition be an innovation which was not 'obvious * * * to a person having ordinary skill in the art.' In the Bausch & Lomb case we found that 'the most competent workers in the field had for at least ten years been seeking a hardy, tenacious coating to prevent reflection; there had been a number of attempts, none satisfactory; * * * when it appeared, it supplanted the existing practice and occupied substantially the whole field.' 224 F. 2d at page 535. Here there is no evidence that there had been any sustained effort over a period of time to find a way of combining the top bar and sweat bar of sun glasses. Nor was it shown that there was a great demand in the industry for such a combination * * *" (p. 227).

Thus, the Court recognizes the necessity of evidence to establish the existing conditions within an industry at the time an invention was made in order to determine whether that invention was "obvious" to a man skilled in the art at that time. This recognition of the importance of such evidence in meeting the issue of patentability makes the decision of the court below in the *Welsh Manufacturing Co.* case, *supra,* in conflict with the decision of the court below in the case at bar where the Court summarily invalidated petitioner's patent and denied it the right to offer evidence of invention.

The existing confusion in judicial thinking regarding the statutory test of patentability demonstrates the need for a definitive ruling by this Court on that subject.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be granted.

Respectfully submitted,

W. Brown Morton Jr.,
Attorney for Petitioner.

November 7, 1956.